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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/505,619

Applicant(s)

KATZ ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 172-177, 179-194 and 196-219 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 172-177, 179-194 and 196-219 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/6/2006</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/20/2006 has been entered.

### ***Response to Amendment***

2. The applicant has neither amended nor canceled or added new claims and has requested to consider the previously submitted arguments and request for reconsideration on 9/20/2006. Currently claims 172-177, 179-194, and 196-219 are pending for examination.

### ***Response to Arguments***

3. The applicant has neither amended nor canceled or added new claims and has requested to consider the previously submitted arguments and request for reconsideration on 9/20/2006. The arguments filed by the applicant on 9/20/2006 (See page 15 of Remarks) are not persuasive. The referred portions of the applicant's Specification, p.14, lines 9-11 and p.32, lines 4-6 do not provide support or disclose the recited limitation, that is, "establishing a communication between at least one of the users and the system for purpose of a primary transaction for a first good or service, the first good or service being currently available at a time of the communication". therefore, all the rejections and objection submitted in the Final office action mailed on 6/20/2006 are sustainable and reproduced below.

This is a continuation of applicant's earlier Application No. 09/505619. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

### ***Specification***

4. The amendment filed 12/19/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

" the first good or service being currently available at a time of the communication", (see lines 6-7 of claim 172) and " offering the second good or service to the to the prospective customer in lieu of the first good or service whereby the upsell serves to obviate the purpose for the primary transaction such that the first good or service is not offered to the prospective customer . " (see claim 172, lines19-22).

The disclosure of the applicant does not teach specifically that the first good or service is currently available at the time of establishing a communication for a purpose of primary transaction for first good or service. Rather the applicant's specification, like Joseph, teaches considering offering upsell when the requested item is not available, see patent '513, col.10, lines 25-33.

The disclosure, further, see col.19, lines 24-38 teaches that the upsell serves to obviate the purpose for the primary transaction only when the purpose of the primary transaction is a

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customer service or repair. The disclosure does not teach that the upsell serves to obviate the purpose for the primary transaction if the purpose of primary transaction is goods.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

5.1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 172-177, 179-194, and 196-219 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim 172 contains subject matter, "the first good or service being currently available at a time of the communication", (see lines 6-7 of claim 172) and "offering the second good or service to the to the prospective customer in lieu of the first good or service whereby the upsell serves to obviate the purpose for the primary transaction such that the first good or service is not offered to the prospective customer." (see claim 172, lines 19-22). which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure of the applicant does not teach specifically that the first good or service is currently available at the time of establishing a communication for a purpose of primary transaction for first good or service. Rather the applicant's specification, like Joseph, teaches considering offering upsell when the requested item is not available, see patent '513, col.10, lines 25-33. The disclosure, further, see col.19, lines 24-38 teaches that the upsell serves to obviate the purpose for the primary transaction only when the purpose of the primary transaction is a customer service or repair. The disclosure does not teach that the upsell serves

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to obviate the purpose for the primary transaction if the purpose of primary transaction is goods. Since claims 173-177, 179-194 and 196-219 are dependencies of claim 172 they are also rejected for the same reason.

Claim 174 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim 174 contains subject matter, " the primary transaction is a purchase transaction and the upsell transaction is a service transaction", which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure, , see col.19, lines 24-38 teaches that the upsell serves to obviate the purpose for the primary transaction only when the purpose of the primary transaction is a customer service or repair. The disclosure does not teach that the upsell is for a service transaction which obviates the purpose for the primary purchase transaction.

6. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7.1. Claim 172-177, 179-183, 189-194, 200-202, 208-212, and 219 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch in view of Wagner [Wagner, Lon (Staff Writer); Fry Fight As Fast-Food Chains Face Off With French Fries, We Weigh The Issue For You"; Virginian-Pilot, Norfolk, Va; April 06, 1997 extracted on Internet from Proquest Database] in view of Perkins [Perkins, Ed; " Consumer Reports On Travel Careful shopping will avoid bait-and-switch promotions"; The Atlanta Constitution; Atlanta, Ga; Jan 4, 1995 extracted on Internet from Proquest Database] and further in view of Kurtzman [Kurtzman, II et al. US Patent 6,144,944]

Regarding claim 172, Lynch teaches a method for providing offers of an item constituting a good or a service to prospective customers as users of the system, utilizing an electronic communications device (see at least abstract. Lynch offers travel-related products and services via a communication device.) comprising the steps:

establishing a communication between at least one of the users and the system for purpose of a primary transaction for a first good or service, the first good or service being currently available at a time of the communication (see at least Figs 1, 2, 3 "104- Receive Travel Request Information" and col.4, lines 13-18 show receiving a request for the purpose of a primary transaction of knowing information about a travel related product/service or purchasing

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a travel related product/service which is available at the time of the communication. Note: Claim 172 is a process claim wherein the novelty is claimed with reference to manipulative steps and not in relation to an attribute of an article. In the establishing step the novelty is to be analyzed with respect to the step of establishing a communication between users and the system for a transaction for a good/service and not with respect to the condition of good/service because the step of establishing a communication between users and the system for a transaction for a good/service would be implemented irrespective of the fact the good/service is available or not and Lynch very well satisfies this condition.);

obtaining primary transaction data with respect to the primary transaction, including the identity of the prospective customer and the purpose of the primary transaction as being a communication for the good or service, utilizing the identity of the prospective customer to obtain at least a second data element relating to the user, utilizing in part the primary transaction data including the purpose of the primary transaction as being a communication for one of the first good or service and the second data element ( see at least col.5, lines 7- col.8, line 44, wherein Lynch discloses receiving primary transaction data, such as dates of travel, requirement of hotel services, automotive rental, etc for the primary transaction of submitting a response to the customer's request for a proposed travel itinerary, utilizing the identity of the customer and obtaining a second data element, such as the traveler's preferences for air carriers, automotive rental agencies, etc. and then utilizes the primary transaction data and the second data element to determine and generate a recommended travel plan. Note: As per the definition provided by the applicant, see Patent'513, col.13, lines 26-51 the term "good(s)" or "service(s)" is to be used interchangeably and both "good(s)" or "service(s)" include promotional material, coupon, ticket, printed material, etc. Therefore, in Lynch, the request for travel



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packages/plans including air tickets, hotel reservations, auto rentals, etc. satisfy the definition of for "good(s)" or "service(s)" as stated in the applicant's disclosure.);

Lynch does not disclose determining a second good or service being currently available for prospective upsell to the prospective customer which is different from the first good or service and offering the second item/service to the prospective customer in lieu of the first good or service whereby the upsell, that is the second good or service serves to obviate the purpose for the primary transaction such that the first good or service is not offered to the prospective customer. However, in an analogous field of endeavor, Wagner (see the article) teaches determining a second good or service being currently available, that is a "Supersize" or "Biggie" fries for prospective upsell to the prospective customer which is different from the first good or service, that is a request of which the purpose was to buy either a large or medium fries and offering the second item/service, that is a "Supersize" or "Biggie" to the prospective customer in lieu of the first good or service, that is a large or medium order request whereby the upsell, that is the second good in the form of "Supersize" or "Biggie" serves to obviate the purpose for the primary transaction such that the first good or service, that is a large or medium order for fries is not offered to the prospective customer. Wagner's teachings are related to Food products but when combined with the disclosure in Perkins [see the full article] which discloses offering alternative travel products at a higher price against the user's request for a low-ball price item as advertised to make more money.

In view of Wagner & Perkins, it would be obvious to one of an ordinary skill in the art at the time of the applicant's invention that suppliers in travel industry would have modified Lynch to incorporate the feature of determining a second good or service being currently available for prospective upsell to the prospective customer which is different from the first good or service and offering the second item/service to the prospective customer in lieu of the first good or

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service whereby the upsell, that is the second good or service serves to obviate the purpose for the primary transaction such that the first good or service is not offered to the prospective customer for the following reasons:

(a) it would help the Lynch's system to offer alternative travel related products and services at a slightly higher price but with upgrades in airline travels or hotel accommodation, etc. thereby adding more revenues and profits if the alternative item is accepted by the customer, as is shown in Perkins and also In Wagner for offering food products.

Note: It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Wagner/Perkins teachings of offering alternative second product obviates the purpose of for the primary transaction and results in getting added revenues to the supplier are reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

Lynch/Wagner/Perkins as applied to claim 172 above discloses offering an upsell item in lieu of first good or service. Lynch further discloses the step of offering items, in real time during the primary transaction (see Lynch at least col.4, lines 25-65, FIG.1 and FIG.2 which disclose a computer based system 24 implementing the automated travel planning system via local or wide area networks which let users interact online with the system in real time), which in view of above analysis and combining the prior teachings of Wagner/Perkins would also include the offering of upsell item, that is the second item in lieu of first good or service . Lynch does not disclose the step of determining the prospective upsell in real time with the primary

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transaction. However, in the analogous field of conducting electronic commerce and targeting advertisements for promoting sale of items, falling in class 705/26 and related class 705/14, Kurtzman teaches the step of determining a prospective advertisement to be displayed to the user in real time when the user sends a request to a web server (see at least col.1, line 43-col.2, line 20, " *On the World Wide Web (or web), advertisers can target specific markets with more discrimination than other media. The information presented to the user is dynamically generated so advertisers can select an appropriate advertisement in real time for that specific user. Thus, the manner in which content is presented on the web means that advertisers can reach increasingly defined segments of the market. For example, a high percentage of people who access a stock quotes web page may be interested in a stock broker. A stock broker who places an advertisement on this web page may reach a smaller group of people, but a much higher percentage of this group will be potential customers. This is in stark contrast to other media such as newspaper and television, in which the target market may only be a small percentage of the total market reached.....* " *Note: The prior art as disclosed in Kurtzman is reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Kurtzman is faced with the problem of immediately determining an appropriate content related to selling goods/service to a user and displaying the same to the user, when the user sends a query to a web server and this problem is similar to the problem faced by the applicant, that is determining a upsell item immediately when the customer is conducting a business for a primary item. In Kurtzman, sending a query for information to the web server corresponds to conducting a primary transaction and determining an appropriate advertisement for promotion of selling products/services to be displayed to the user corresponds to determining a prospective upsell item. In both the cases the problem is solved by presenting the advertisement in real time while the user is online waiting for a response from a web server in response to his query [Kurtzman]*

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and by presenting an appropriate upsell item in real time while the user is conducting a transaction [Instant application]. In view of Kurtzman, it would be obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Lynch/Wagner/Joseph as applied to claim 172 to incorporate the feature of determining the prospective upsell in real time with the primary transaction because, as explicitly suggested in Kurtzman, not to let the customer wait and thereby losing the opportunity to present upsell items/advertisements to the customers.

Regarding claims 173 and 176, the limitations that the primary transaction type differs from the transaction type of the upsell transaction and that the goods/services of first transaction differs from that of the upsell transaction are already covered in the rejection and analysis of claim 172 above because the upsell transaction is directed to a different product with a higher price than the primary transaction.

Regarding claims 174-175, and 177 their limitations are covered in claim 172 because as per the definition of goods and services, see above, both of these terms are to be used interchangeably and include tickets and printed material. Lynch, as shown above, discloses that the request denoting the primary transaction is a service transaction for purchase of a travel plan including airline tickets/hotel booking, auto rental etc. and that the upsell transaction is also for a purchase transaction for a replacement product for the first good in the primary transaction, that is "service(s)" as per the definition of "services" stated by the applicant.

Regarding claims 179-183, Lynch/Wagner/Perkins/Kurtzman further discloses that the primary transaction could be: not consummated, a purchase transaction, a service transaction,

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a sale transaction, an informational enquiry and (see at least Lynch col.8, lines 19-27, which discloses booking arrangements that meet the requirements of the itinerary and this corresponds to a purchase transaction for the buyer, a sales transaction for the seller. It also includes service related transactions such as, transactions for automotive rentals, hotel bookings. Col.4, lines 13-24 further discloses receiving a travel request information, this corresponds to the claimed informational enquiry, and that consummation occurs if the recommendations fall within parameters of travel itinerary which implies that if they do not match the parameters of travel itinerary the primary transaction will not be consummated. ).

Regarding claims 189 –194, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 teaches a method for providing offers of an item constituting a good or a service to prospective customers as disclosed and analyzed above. Lynch/Joseph/Walker/Kurtzman further discloses utilizing time as a factor in determining the goods or service to be offered, wherein the time is the time of the day/day of the week/day of the month/proximity to a calendar event which is user defined (see Lynch at least col.5, lines 21-30. In the field of traveling, utilizing time as a factor in determining the goods or service to be offered is very well known, such as when purchasing vacation packages/airline tickets/hotel bookings, restaurants bookings.

Regarding claims 200 and 201, their limitations are already covered in claim 172 while analyzing the limitations, " utilizing at least in part the primary transaction data....".

Regarding claim 202, its limitations are already covered in claim 172 while utilizing the limitation, " ...utilizing the identity of the prospective customer to obtain at least a second data element

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*relating to the user*". Lynch's invention considers the user's preferences , such as type of airline, hotels, airplane seats and they correspond to the quality of goods/services.

Regarding claims 208-211, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 teaches a method for providing offers of an item constituting a good or a service to prospective customers utilizing an electronic device as disclosed and analyzed above. Lynch/Wagner/Perkins/Kurtzman further disclose that the prospective customer registers to use the system/pre-registers with the system prior to use/ wherein the registration includes input of information by the prospective customer/wherein the prospective customer inputs information in response to questions (see at least Lynch, col.1, lines 61-col.2, line 15, col.3, lines 38-47).

Regarding claim 212, Lynch/Wagner/Perkins/Kurtzman further discloses at least one negative rule when the at least one item for prospective upsell to the prospective customer is determined (see at least Lynch col. 3, line 63-col.4, line 13 which discloses that while generating a response to the customer's travel information request the system also determines that the recommended plan is consistent and conform to the business entity portfolio information and the travel agency's preferences).

Regarding claim 219, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 further discloses that the electronic communications device is a computer (see at least Lynch, FIG.1, FIG.2, " 34", and col.4, lines 25-65).

7.2 Claims 184-188 are rejected under 35 U.S.C. 103(a) as being obvious over Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 in view of Official Notice.

Regarding claims 184-188, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 teaches a method for providing offers of an item constituting a good or a service to prospective customers utilizing an electronic device as disclosed and analyzed above.

Lynch/Wagner/Perkins/Kurtzman does not disclose that the primary purpose of the primary transaction is an inventory check/ a status inquiry an order fulfillment inquiry/ a comparison shopping inquiry/ and a credit check. Official Notice is taken of both the old and well known concepts and benefits of seeking an inventory check/ a status inquiry /an order fulfillment inquiry/ a comparison shopping inquiry/ and a credit check for the obvious reason of knowing if the goods or services are available, if the pending order is completed or when it will be delivered, to get the best available, and to know how if the goods can be purchased by using the credit cards. In view of the Official Notice it would be obvious to a person of an ordinary skill in the art at the time of the invention to have modified Lynch/Wagner/Perkins/Kurtzman to include the old and well-known features of seeking an inventory check, i.e. an availability check/ a status inquiry /an order fulfillment inquiry/ a comparison shopping inquiry/ and a credit check for the obvious reason of knowing if the goods or services are available, if the pending order is implemented or when it will be delivered, to get the best available, and to know how if the goods can be purchased by using the credit cards.

7.3. Claims 196-199 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch/Wagner/Perkins/Kurtzman in view of Pocock (US Pub. 2002/0023272 A1).

Regarding claims 196-199, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 teaches a method for providing offers of an item constituting a good or a service to prospective customers utilizing an electronic device as disclosed and analyzed above.

Lynch/Wagner/Perkins/Kurtzman does not disclose using geographic identifier data of the user

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to offer a good or service wherein the geographic identifier is provided automatically/by a carrier associated with the electronic communication device and the geographical identifier data is entered by the user. However, in the same field of electronic commerce, Pocock teaches using geographic identifier data of the user to offer a good or service wherein the geographic identifier is provided automatically/by a carrier associated with the electronic communication device and the geographical identifier data is entered by the user (see at least paragraphs 0014 and 0016 on page 2. Pocock discloses here that the geographical identifier data of the user is provided automatically from the area code of the telephone number entered by the user or supplied by the telephone company's [ANI]...to enable the programmed data processor to select the programmed schedule and the related information about the song which is to be offered and purchased by the customer.). In view of Pocock it would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 to include the feature of using geographic identifier data of the user to offer a good or service wherein the geographic identifier is provided automatically/by a carrier associated with the electronic communication device and the geographical identifier data is entered by the user because it will help to identify the location of the user and using that information to provide discounted coupons and upsells for those goods and services which are available in the user's close vicinity.

7.4 Claims 203-207 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch/Wagner/Perkins/Kurtzman and further in view of Kenney (US Patent 6,381,583).

Regarding claims 203-207, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 teaches a method for providing offers of an item constituting a good or a service to prospective customers utilizing an electronic device as disclosed and analyzed above.



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Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 does not disclose that the offer is made orally/visually/visual offer includes a virtual reality display/visual offer is static or dynamic. However, Kenney teaches that the offer is made orally (see Kenney col.3, lines 5-9, "...advertisement including audio information", and col.10, lines 24-28, ".audible information can also be provided...", /visually/visual offer includes a virtual reality display/visual offer is static or dynamic (see at least col.6, line 60-col.29, "...display means 12 causes the displayed video image to change at the shopper's command to correspond to what the shopper would see.....allow the shopper to interact with the display of one aisle of the grocery store 2...."). In view of Kenney it would be obvious to a person of an ordinary skill in the art at the time of the applicant's invention to modify Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 to incorporate the features of Kenney that the offer is made orally/visually/visual offer includes a virtual reality display/visual offer is static or dynamic as explained above for the obvious reason of letting the customer have the feeling of shopping as face to face, examine the individual offered items and make a selection, as explicitly stated in Kenney (see at least col.1, lines 30-48) and thereby making the user's shopping experience fast and convenient and at the same time enabling the merchants to increase sales, and profits economically and efficiently.

7.5. Claims 213-214 are rejected under 35 U.S.C. 103(a) as being obvious over Lynch/Wagner/Perkins/Kurtzman as applied to claim 212 and further in view of Official Notice.

Regarding claims 213, and 214, Lynch/Wagner/Perkins/Kurtzman teaches applying a negative rule in offering an upsell item, as analyzed for claims 172 and 212 above but does not disclose that the negative rule includes not offering for up sell an item determined to already be possessed/purchased by the prospective customer. The examiner takes Official Notice of the

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well-known fact that goods/services are promoted/advertised and offered to a consumer based upon the consumer's history, dislikes and preferences and while doing so the customer's past transactions relating to purchases/ of goods/services [if the consumer has purchased a good/service it implies he possessed that good/service]. For, example if the feedback from the consumer's profile shows that he was not happy with a item that he purchased and possessed, such as automobile, appliance, cruise line, vacation package in the past then it would be obvious to one of an ordinary skilled in the art that those items would not be offered as promotional items or upsells because he would not accept them. In view of the Official Notice, it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention o modify Lynch/Wagner/Perkins/Kurtzman to incorporate the feature of not offering for up sell an item determined to already be possessed/purchased by the prospective customer because as analyzed above if a customer was not happy with a item that he purchased and possessed, such as, a particular cruise , vacation package in the past then it would be obvious to one of an ordinary skilled in the art not to offer them as promotional items or upsells because he would not accept them and the efforts, time and money spent in offering the promotion/upsell would be wasted.

7.6. Claim 215 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch/Wagner/Perkins/Kurtzman as applied to claim 212 and further in view of Bernard et al. (US Patent 5,918, 213), hereinafter, referred to as Bernard.

Regarding claim 215, Lynch/Wagner/Perkins/Kurtzman as applied to claim 212 teaches a method for providing offers of an item constituting a good or a service to prospective customers utilizing an electronic device and using at least one negative rule when the at least one item for prospective upsell to the prospective customer is determined as disclosed and

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analyzed above. Lynch/Wagner/Perkins/Kurtzman does not disclose that the negative rule includes not offering an item determined to have been previously offered to the prospective customer but declined. However, in the same field of electronic commerce, Bernard teaches that the negative rule includes not offering an item determined to have been previously offered to the prospective customer but declined (see at least claim 1, col. 61, line 48-col.62, line 11, *".... means for determining an abusive status of the customer..... means for defining a predetermined abusive user status time limit.....wherein said limiting usage includes disconnecting the abusive customer from the product system after said customer has been connected to said product system for said abusive user status time limit...."*). Note: Disconnecting the user who does not purchase when he is offered items to purchase corresponds to applying negative rule of not offering an item to a user who has previously declined to purchase the items.). In view of Bernard, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Lynch/Wagner/Perkins/Kurtzman as applied to claim 212 to incorporate the feature of applying negative rule of not offering an item to a user who has previously declined to purchase the items because to avoid wasting the resources in attempting to sell products to a user who is not interested in them.

7.7. Claims 216-217 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 and further in view of Tagawa (5,732,398)

Regarding claims 216-217, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 teaches a method for providing offers of an item constituting a good or a service to prospective customers utilizing an electronic device as disclosed and analyzed above. Lynch/Wagner/Perkins/Kurtzman does not disclose that the prospective customer interacting with a live operator, and that the electronic device is a telephone. However, in the same field of

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providing travel related products/services, Tagawa discloses that a prospective customer can interact with a live operator, and that the electronic device is a telephone (see col.2, lines 1-5, col.8, lines 43-47 and FIG.1, " 34"...."). In view of Tagawa, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 to incorporate the feature of a prospective customer interacting with a live operator, and that the electronic device is a telephone because talking to a live operator over telephone can resolve issues, such as rectifying errors made while using automated computer system, t refunds or any other complex issues not resolved by the automated system.

7.8. Claim 218 is rejected under 35 U.S.C. 103(a) as being obvious over Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 and further in view of Gerszberg et al. (US Patent 5, 970,473), hereinafter, referred to as Gerszberg.

Regarding claim 218, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 teaches a method for providing offers of an item constituting a good or a service to prospective customers utilizing an electronic device as disclosed and analyzed above.

Lynch/Wagner/Perkins/Kurtzman does not disclose that the electronic device is a videophone. However, in the same field of electronic commerce, Gerszberg discloses using videophone providing an interface for purchasing goods and services online (see at least col.1, lines 5-8, FIG.1 "130-Videophone", col.4, lines 20-25, "...digital phone 18 and/or videophone 130.."). In view of Gerszberg, it would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 to incorporate the feature of Gerszberg to use videophone to communicate with the shopping facility for the

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obvious reason of enabling the user to view the person with whom he is speaking as explicitly disclosed in Gerszberg (see at least col.6, lines 44-60).

### ***Conclusion***

8. This is a continuation of applicant's earlier Application No. 09/505619. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

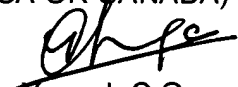
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Yogesh C Garg  
Primary Examiner  
Art Unit 3625

Y.C.G.  
12/5/06